UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
TESLOVICH, TAMARA

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/928,026	PIIKIVI, LAURI
		Examiner	Art Unit
		Tamara Teslovich	2137

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>10 August 2001</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-16</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-16</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>10 August 2001</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☒ All   b) ☐ Some * c) ☐ None of:

   1. ☒ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>04.12.02 08.10.01</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

The following title is suggested: Secure E-commerce Transactions Utilizing SET

Security Protocols and EMV Cryptograms.

The abstract of the disclosure is objected to because it refers to the disclosure of

both a device and a method while none of Applicant's claims discloses a method.

Correction is required. See MPEP § 608.01(b).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4)

because reference character "22" has been used to designate both a "payment startup

message" and an "acknowledge result message".

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the

description: In lines 12-23 of page 11, Applicant refers to the "standard SET payment

initialization message 15" of Figure 2, however Figure 2 does not include any "standard

SET payment initialization message 15".

The drawings are objected to because they do not include descriptive labels.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. Each drawing sheet

5   submitted after the filing date of an application must be labeled in the top margin as

either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the

changes are not accepted by the examiner, the applicant will be notified and informed of

any required corrective action in the next Office action. The objection to the drawings

will not be held in abeyance.

10

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

15

Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 4 recites the limitation "the mobile station" in lines 2-3. There is insufficient

20   antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "device station according to claim 1" in line 26, page

16. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

5   (e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
10   only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Harris

15   et al. (United States Patent 6,681,328 B1).

As per Claim 1, Harris teaches a device comprising:

connecting means for establishing a communication link with a second party

[distributed communication network] (see Harris col.2 lines 38-41);

20   selection means connected to receive a control message signal from said second

party said signal including a plurality of selectable security protocols and in response

thereto to select one of the plurality of security protocols (see Harris col.4 lines 47-56);

whereby information transferred subsequently between the device and second

party is protected using the selected security protocol (see Harris col.4 lines 31-46).

25

As per Claim 2, Harris teaches a device according to claim 1 wherein said

selection means further comprises:

analysis means which analyses the data contained in said control message

signal and in response thereto selects the security protocol (see Harris col.8 lines 65-

67).

5   As per Claim 3, Harris teaches a device according to claim 1 further comprising:

calculating means for generating an EMV cryptogram from data held in at least

one data field of the control message signal (see Harris col.4 lines 32-36).

As per Claim 4, Harris teaches a device according to claim 3 further comprising:

10   cryptogram transmitting means provided to transmit the EMV cryptogram from

the mobile station to initiate secure transfer of information from the device (see Harris

col.4 lines 35-38).

As per Claim 5, Harris teaches a device according to claim 1 further comprising:

15   means to provide a start payment signal from the device to the second party

which thereby initiates the control message signal from the second party (see Harris

col.4 lines 1-3).

As per Claim 6, Harris teaches a device according to claim 1 further comprising:

20   means for communicating, when said selected security protocol is the SET

standard, with a modifed SET wallet server [switch system] which is adapted to receive

an EMV cryptogram generated by the device and thereafter to communicate with a SET

payment gateway via the second party according to the SET standard (see Harris col.4

line 40 thru col.5 line 29) .

As per Claim 7, Harris teaches a device station according to claim 1 further

5   comprising:

means for communicating, when said selected security protocol is the EMV

standard, with the second party directly via an EMV cryptogram generated via the

device (see Harris col.4 lines 32-39).

10   As per Claim 8, Harris teaches a device according to claim 1 wherein the control

message signal comprises a series of data fields each containing data indicating a

predetermined parameter for the transaction (see Harris col.4 lines 26-31).

As per Claim 9, Harris teaches a device according to claim 1 wherein the control

15   signal includes a data field which indicates whether the device can communicate

directly with the second party or with the second party via a modified SET wallet [switch

system] (see Harris col.4 line 40 thru col.5 line 29).

As per Claim 10, Harries teaches a device according to claim 1 further

20   comprising:

internet browsing circuitry which enables a user of the device to access and

browse the internet via the device (see Harris col.4 lines 1-3).

As per Claim 11, Harris teaches a device according to claim 10 wherein said

connecting means enables a connection to be established between said device and a

second party via the Internet (see Harris col.4 lines 1-3).

5

As per Claim 12, Harris teaches a device according to claim 1 wherein said

device comprises a mobile station (see Harris Figure 1).

As per Claim 13, Harris teaches a device according to claim I wherein said

10   second party comprises a merchant server associated with a merchant [service

provider] offering an item to be purchased (see Harris col.4 lines 1-4).

As per Claim 14, Harris teaches a device comprising:

connecting means for establishing a communication link with a second party

15   [distributed communication network] (see Harris col.2 lines 38-41);

selection means for selecting one of a plurality of security protocols and being

connected to communicate said selection to said second party (see Harris col.4 lines

47-56); and

calculating means for generating an EMV cryptogram for transmittal from said

20   device (see Harris col.4 lines 31-46); whereby

information transferred subsequently between the device and second party is

protected using the selected security protocol (see Harris col.4 lines 31-46).

As per Claim 15, Harris teaches a device comprising:

connecting means for establishing a communication link with a second party [distributed communication network] (see Harris col.2 lines 38-41);

5   selection means for selecting a SET security protocol and being connected to communicate said selection to said second party (see Harris col.4 lines 47-56); and

calculating means for generating an EMV cryptogram for transmittal from said devices whereby information transferred subsequently between the device and second party is protected using the SET security protocol (see Harris col.4 lines 31-46).

10

As per Claim 16, Harris teaches a device comprising:

connecting means for establishing a communication link with a second party [distributed communication network] (see Harris col.2 lines 38-41);

selection means for selecting a EMV security protocol and being connected to

15   communicate said selection to said second party (see Harris col.4 lines 47-56); whereby

information transferred subsequently between the device and second party is

protected using the EMV security protocol (see Harris col.4 lines 31-46).

20   Claims 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Wankmueller (United States Patent Application Publication US 2001/0027441 A1).

As per Claim 14, Wankmueller teaches a device comprising:

connecting means for establishing a communication link with a second party

(see Wankmueller paragraph 23);

selection means for selecting one of a plurality of security protocols and being

connected to communicate said selection to said second party (see Wankmueller

5   paragraph 30); and

calculating means for generating an EMV cryptogram for transmittal from said

device (see Wankmueller paragraph 29); whereby

information transferred subsequently between the device and second party is

protected using the selected security protocol (see Wankmueller paragraph 30).

10

As per Claim 15, Wankmueller teaches a device comprising:

connecting means for establishing a communication link with a second party (see

Wankmueller paragraph 23);

selection means for selecting a SET security protocol and being connected to

15   communicate said selection to said second party (see Wankmueller paragraphs 30 and

6); and

calculating means for generating an EMV cryptogram for transmittal from said

devices whereby information transferred subsequently between the device and second

party is protected using the SET security protocol (see Wankmueller paragraphs 29 and

20   6).

As per Claim 16, Wankmueller teaches a device comprising:

connecting means for establishing a communication link with a second party (see

Wankmueller paragraph 23);

selection means for selecting a EMV security protocol and being connected to

communicate said selection to said second party (see Wankmueller paragraph 30);

5   whereby

information transferred subsequently between the device and second party is

protected using the EMV security protocol (see Wankmueller paragraph 30).

10   ***Conclusion***

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tamara Teslovich whose telephone number is (571)

272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

15   supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

5   For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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Tamara Teslovich
March 14, 2005

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER